

REMARKS

The Office Action has been carefully considered. Claims 11, 12, 32, 33 and 45 as well as new claims 46-48 are pending in the present application. Claims 13-31 and 34-44 are canceled. Applicants acknowledge with appreciation the allowance of claims 11, 12 and 45. Claims 46-48 have been added to specify certain types of cancer to be treated by Compound I. These new claims are fully supported by the originally-filed specification at, for example, page 7, lines 14-18. Thus, no new matter has been added.

Reconsideration of the present application and entry of the above amendments in view of the following remarks are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 32 and 33 are rejected under 35 U.S.C. §112, first paragraph. The Examiner alleges that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Specifically, the Examiner alleges that the specification, while enabling for methods for treating specific cancer diseases, does not reasonably provide enablement for all cancer diseases. This rejection is respectfully traversed.

“It is well settled that patent applicants are not required to disclose every species encompassed by their claims, even in an unpredictable art.” In re Vaeck, 947 F.2d 488, 496 (Fed. Cir. 1991) (citing In re Angstadt, 537 F.2d 498, 502-03 (Fed. Cir. 1976)). A claim is enabled even if thousands of embodiments must be screened to determine their success. See Angstadt, 537 F.2d at 502-03 (finding that the claims were enabled even though the disclosure did not disclose every working catalyst encompassed by the claims). Requiring the “disclosure of a test with every species covered by a claim . . . would force an inventor seeking adequate patent protection to carry out a prohibitive number of actual experiments. This would tend to discourage inventors from filing patent applications in an unpredictable area since the patent claims would have to be limited to those embodiments which are expressly disclosed.” Id. at 503. Furthermore, experimentation to determine which compounds will successfully behave in a claimed process is not undue when the applicants “have supplied the list of [compounds] and have taught how to make and how to use them.” Id.

The present application provides directions on how to prepare the compound of claim 1 (“Compound I”), which is the compound used in claims 32 and 33. In order to

determine whether Compound I is successful at treating a particular type of cancer, one of skill in the art would understand how to conduct cytotoxic activity assays, like those described in the attached Bombardelli Declaration. Using comparative cytotoxic activity assays, the inventors were able to determine that Compound I inhibits the cell growth of various types of cancer. In particular, Compound I inhibited the cell growth of MCF-7 breast carcinoma cells, drug-resistant MCF-7 breast carcinoma cells, drug-resistant A2780 ovarian carcinoma cells, and drug-resistant colon adenocarcinoma HCT-15 cell line. (See Bombardelli Declaration, para. 5-9). One of ordinary skill in the art would recognize that these assays could be run to test other types of cancers within the scope of claims 32 and 33. Therefore, the experimentation necessary to determine the forms of cancer that Compound I is effective in treating is not undue since the specification describes how to make Compound I, and one of ordinary skill would understand how to conduct a cytotoxic activity assay to determine if such compound is effective in treating cancer cells.

Accordingly, withdrawal of these rejections and allowance of claims 32 and 33 are respectfully requested.

CONCLUSION

As the claim rejections have been overcome, all pending claims are believed to be in condition for allowance. An early notice to that effect would be appreciated. Should the Examiner not agree with Applicants' position, a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No fee is believed to be due for this Amendment other than the fee for the petition of extension of time. Should any additional fees be required, please charge such fees to Jones Day Account No. 503013.

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Respectfully submitted,

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